REMARKS

Summary of Action

In the subject office action, the Examiner rejected

(a) claims 1-2, 4-9 and 11-14 under 35 USC 103 as being unpatentable over Maxwell (USP 5,805,810) and Yacoub (USP 6,452,692) combined;

(b) claims 3, 10, and 15 under 35 USC 103 as being unpatentable over Maxwell (USP 5,805,810), Yacoub (USP 6,452,692) and Heiden (USP 6,408,286) combined; and

(c) claims 16-18 under 35 USC 102(e) as being anticipated by Heiden (USP 6,408,286).

Summary of Response

In response to the 103(a) rejections, Applicants have cancelled claim 7 (without prejudice), amended claims 1-2, 5-6 and 11 to further particularized the present invention. Additionally, Applicants have amended claims 3-4, 8-10, 12-15 to either conform the claims to amended claims 1, 5 and 11, or to correct previously undetected informalities, which are unrelated to the cited references.

In response to the 102(e) rejections, Applicants respectfully traverse the Examiner's rejections below. However, Applicants have taken this opportunity to make minor adjustments to the claim language of claims 16-18. The amendments are unrelated to the cited references, and are not made to overcome them.

All amendments are fully supported by the original disclosures. No new matters have been introduced.

Rejection of claims 1-2, 4-9 and 11-14 under 35 USC 103(a)

Claims 1, 5 and 11

The Examiner asserted that Maxwell teaches a print server, a storage device, a processor, the storage device storage a program to control the processor, the processor operative with the program to receive an electronic message that include message attributes including a message recipient, determine a recipient physical address ..., and compare the message recipient physical address with the plurality of printing locations. What Maxwell failed to teach, i.e. a database containing attributes of a plurality of printing locations, receiving print criteria, querying the printing locations, selecting one of the printing locations, and sending the electronic message to the selected printing location, the deficiencies are remedied by Yacoub.

Applicants respectfully disagree.

Applicants respectfully submit that the combination of Maxwell and Yacoub still fails to teach at least the required operation of ***comparing the message recipient's physical address to a plurality of printing locations.***

Figure 2 of Maxwell and its corresponding descriptions merely disclosed the employment of a single print server having a print queue processor. Starting on or about col. 7, line 60, and running through col. 11, line 46, Maxwell disclosed a Message Validator for use to validate a received electronic message. Starting on or about col. 10, line 32, Maxwell disclosed that when "no exception messages" have been generated as part of the "validation" process, and after building and queuing for transmission an "accept" message for the sender, the Message Validator builds a mail object ("the message") and queues the mail object in the print queue for printing.

Starting on or about col. 12, line 38, running through col. 13, line 10, Maxwell disclosed the operation of the print queue processor.

Nowhere in these descriptions of Maxwell can Applicants find any teaching on the required operation of ***"comparing the message recipient physical address to a plurality of printing locations***".

Yacoub teaches a print server for printing jobs on networked printers. The print server receives preferences regarding a print job the user wishes to send such as speed and image quality. The server determines, using a database or other query, the most appropriate printer complying with the print job preferences that is located physically near the user (sender of the print job), and spools the print job to that printer. See e.g. the Abstract. In col. 6, lines 25-48, Yacoub further describes this operation of selecting a printer that is located physically near the user (sender of the print job), by computing the distance between the locations of the user (sender of the print job) and a printer candidate, using their respective coordinates.

Accordingly, even if we assume Yacoub's print job may be equated with the printing of a message being sent from a sender to a recipient, the "proximity" analysis performed in Yacoub is nevertheless a "proximity" analysis of the locations of the user (i.e. sender of the print job) and the printers, and not the required "proximity" analysis of the locations of the recipient and the printers.

Accordingly, Applicants submit the combination of Maxwell and Yacoub still fails to teach at least the required element of "***comparing the message recipient's physical address to a plurality of printing locations***".

Further, Applicants respectfully remind the Examiner that section 103(a) requires that the invention be viewed as a whole. Additionally, the court has repeatedly admonished on the necessity of the cited references to contain suggestion of the modifications and or combinations.

For the issues at hand, Applicants submit there is no disclosure in either Maxwell nor Yacoub to suggest first modifying the "proximity" analysis of sender and

printer locations to "proximity" analysis of recipient and printer locations, and then further extending the modified "proximity" analysis from the disclosed network print application to a mailing application, where the printed materials are known to have to be mailed.

There is nothing in Maxwell or Yacoub to suggest there may be a disadvantage with the usage of Postal/Delivery service, and that usage of Postal/Delivery service may be further improved by taking into account the recipient's physical address and the printing locations.

The Examiner is not permitted to use Applicants disclosure as a guide. That's impermissible use of hindsight.

Accordingly, claims 1, 5, 11 are patentable over Maxwell and Yacoub combined.

Claims 2, 4, 5, 8-9 and 12-14

Claims 2, 4, 6, 8-9, and 12-14 depend on claims 1, 5 and 11 respectively, incorporating their limitations. Therefore, for at least the same reasons, claims 2, 4, 6, 8-9, and 12-14 are patentable over Maxwell and Yacoub

Rejections of claims 3, 10 and 15 under 35 USC 103(a)

Claims 3, 10 and 15

Heiden does not remedy the above described deficiencies of teaching of Maxwell and Yacoub. Accordingly, even if Maxwell and Yacoub are further combined with Heiden, claims 1, 5, and 11 are still patentable over these references.

Claims 3, 10 and 15 are dependent on claims 1, 5, and 11, incorporating their limitations. Accordingly, for at least the same reasons, claims 2, 4, 6, 8-9, and 12-14 are patentable over Maxwell, Yacoub and Heiden combined.

Rejections of claims 16-18 under 35 USC 102(e)

Claim 16

In rejecting claim 16, the Examiner substantially relied on the teachings on col 7, line 62 to col 8, line 67 of Heiden. Indeed in the referenced passages, Heiden disclosed various criteria that can be applied in selecting advertisements for inclusion, including but not limited to various restriction data (such as sender restriction, addressee restriction, date restriction, multi-ad restriction, piece count restriction, space restriction and so forth), and demographic data (income, age, and so forth).

However, Heiden does not teach how, on a data processing, these multitude criteria are to be processed, in particular, how they can be processed efficiently, especially in view of the fact that an ad may meet one criteria very well, but fail another miserably.

Claim 16 is directed towards a family of techniques for efficiently processing and applying these criteria, including in particular the operations of

> for each ready state advertisement, setting a base priority value;
>
> modifying the base priority value according to predetermined criteria;
>
> sorting the ready state advertisements into a list according to their modified priority values;
>
> re-sorting the list according to ad affinity. (Underline added.)

Applicants respectfully submit that Heiden teaching of "checking restriction criteria" does not anticipate the specific required operation of setting a base priority value. Such checking of restriction criteria may be implemented in any one of a number of manners. Accordingly, it follows that Heiden also does not anticipate the required operation of modifying the base priority value based on the criteria.

Heiden also fails to teach the required sorting operations, which requires the list to be first sorted by the priority values (after they have been modified in accordance with a the predetermined criteria), and then re-sorted by their affinities.

Therefore, claim 16 is patentable over Heiden.

Claims 17-18

Claims 17-18 depend on claim 16, incorporating its limitations. Accordingly, for at least the same reasons, claim 17-18 are patentable over Heiden.

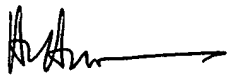
Conclusion

In view of the foregoing, Applicants respectfully submit that claims 1-6 and 8-18 are all in condition for allowance, and early issuance of the Notice of Allowance is respectfully requested.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,
Applicants

Date: May 21, 2003



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